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/Brianna Dahlberg/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Bart Alan MELTZER et al.
Application No.: 09/173,858
Confirmation No.: 4734
Filed: 16 October 1998
Title: **Documents for Commerce in Trading
Partner Networks and Interface
Definitions Based on the Documents**

Group Art Unit: 2178

Examiner: HUYNH, Cong Lac T.

CUSTOMER NO.: 22470

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUMMARY OF INTERVIEW AND REQUEST FOR FOLLOW-UP INTERVIEW

Sir and Madam:

Applicants very much appreciate the time that Examiners Huynh and Hong allowed for an interview on Thursday afternoon, October 18, 2007, beginning shortly after 3 p.m. We especially appreciate convening an interview on short notice, as counsel was visiting from California when the latest office action arrived.

Summary of Interview

The principal topic of discussion was securing additional resources, particularly expertise in evaluating evidence and deciding novel legal issues, to assist the Examiner with a complicated case and an extensive record. The Board referred the case back to the Examiner for initial consideration of new evidence, instructing applicants to file an RCE with the new evidence. Reference back to

the Examiner includes evaluating the hundreds of page of new evidence without taking any cue from or giving any deference to the Board, because the Examiner is making the initial review.

Prosecution has been under way for years, since 1998. The record has swollen to over 2700 pages. Nearly 300 pages of evidence require initial consideration.

Under the new rules, this office action needs to be most effective, because we do not have additional RCEs of right and at least one continuation already has been taken.

We disclosed that the current assignee is Open Invention Network, a consortium with no revenue objectives, which is more fully described at www.openinventionnetwork.com.

We did not address any particular claim and did not offer any amendments.

Section 102(c) Rejection

We discussed the 102(c) rejection for “abandonment” of the invention. We pointed out the Examiner’s factual error: she characterized CBL as our invention. The actual role of CBL is discussed extensively in this application, for instance, in the context of FIG. 7 at pages 42-42 of the original application. While a CBL definition of a document can be used as a component of what we claim, for instance, as an input document or part of an input document, a CBL document definition by itself is not enough to practice our claim. This is clearly supported by the application and the new evidence.

Adding to our interview discussion, we point out that the rejection is based on the mistaken legal premise that allowing the public to use an invention for free before filing would deprive an applicant of the right to obtain a patent. Encouraging the public to use an invention is the opposite of abandoning it.

Weighing of Evidence

We discussed the Examiner’s weighing of evidence. This is a task routinely performed by judges, for which the Office often turns to a specialist.

We began with the meaning of corroboration. In evidence law, corroboration of a witness' testimony means looking for something, anything, which supports or confirms the testimony. It can, for instance, be testimony of another witness, a prior consistent statement by the witness, a document to which the witness refers, or a document from a different source. Corroboration asks whether enough has been presented from any source to give us reason to believe the witness' testimony. Under Rule 131, documentary corroboration is not required, if the lack of documentation is explained.

In this prosecution, the witnesses testified that certain technology was working for its intended purpose before a particular date. During appeal, the issue arose as to whether CBL was working for its intended purpose as of that date (perhaps due the Board's misunderstanding of the relationship between CBL and the claims.) During our interview, we reviewed documentary evidence from the eminent Jon Bosak of Sun Microsystems, which gave 1Q1998 as when he became aware of CBL version 1.0, which corroborates the inventors' testimony. "[Mr.] Bosak is Sun's XML architect. He organized and led the working group that created XML and served for two years as chair of the W3C XML Coordination Group. He is a founding member of OASIS, the Organization for the Advancement of Structured Information Standards, and of its predecessor, SGML Open. At Sun he holds the position of Distinguished Engineer." <http://www.xml.com/pub/au/58>. The 1Q1998 date is strong corroboration from a witness who should know.

We looked at the evidence that the Examiner weighed against our showing and pointed out that it did not support the Examiner's position that version 1.1 was the first version of CBL that worked. What the quote from Glushko actually said was that Commerce One continued to work on and refine CBL in versions 1.1 and 2.0, which were released subsequent to version 1.0. Glushko did not criticize the adequacy of version 1.0 for patent purposes to demonstrate that the technology described in the declaration would work for its intended purpose.

To extend the interview discussion, please look again at pages 10-14 of our RCE (submitted July 23, 2007), which appear (as edited) in an appendix to this interview summary for the Examiners' convenience. Prior consistent statements by Glushko, unrelated to patent prosecution, a book by Sall, remarks by inventor Allen and the slides from Bosak all give us reasons to believe the inventors' testimony about their actual reduction to practice. We argued that new evidence was not given appropriate weight in the recent office action as corroborating evidence.

Meaning of McKendrick

Some of the new evidence demonstrates how one of ordinary skill in the art would understand McKendrick. This is an issue that the Board referred back to the Examiner for initial consideration. We explained that the Examiner relies heavily on one sentence in the article, which McKendrick attributed to Microsoft. We put that sentence into Google and found the Microsoft document that McKendrick quoted. That document is part of the new evidence that the Examiner needs to consider. The article makes it unmistakably clear that Microsoft was teaching and promoting a Remote Procedure Call (RPC) use of XML, which did not use an input document and an output document, as those of skill in the art would understand those terms in the context of this application and web services.

Microsoft's RPC was an alternative protocol, which lost out to the document interface that Commerce One invented. By 2005, Microsoft's Visual Studio development environment was configured to use the document interface instead of the RPC technology about which McKendrick reported in 1998. To assist the Examiner in understanding Microsoft's RPC, we submitted additional articles and a patent by a Microsoft partner that addresses RPC with XML.

The Examiner mistakenly relied on the Board's opinions, instead of considering the new evidence, the level of skill in the art, and how one of ordinary skill in the art would understand the Microsoft teachings to which McKendrick refers.

Proposal on How to Proceed

In the next month, we propose a three-way, two hour interview to work through the evidence, discuss the legal issues with your specialist, and to identify what the Examiners want to see in order to place the case in condition for allowance.

Review of the evidence would take a day in a District Court evidentiary hearing, because the record is lengthy and the technology takes time to understand. We think that a two hour, three-way, study session would be enough to work through the evidence and legal principles, answer the Examiners' questions and reach an agreement as to any supplemental material or claim amendments that the Examiners would see as placing the claims in better condition for allowance.

Legal issues that we propose to address include:

- What the case law considers abandonment to be, under section 102(c)? Whether extensive public use of a technology is the opposite of abandonment, regardless of whether money is paid for a license?
- What the corroboration of testimony means in evidence law? Whether consideration of a Rule 131 declaration begins with the declarants' words? Whether Rule 131 declarations, which are not required by rule to attach written evidence, can be independently corroborated using documents that are not attached to the declarations?
- Whether case law permits a reference to be removed from consideration by evidence other than inventors' declarations?
- Whether a listing of a data structure can prove or constitute an actual reduction to practice?
- Whether the "best evidence rule" requires or encourages the Examiner to set aside and not rely on secondary evidence (McKendrick) of a publication (Microsoft) when the "best evidence", the publication itself is of record?

With these legal issues in mind, we request a two hour, three-way interview including a specialist with expertise in such issues. We propose to understand to the Examiners' views regarding these legal questions and respond

with case law, if appropriate; then, to walk through the evidence and demonstrate (1) how the new evidence, by itself and combined with the inventors' declarations, removes McKendrick as a reference and (2) how one of skill in the art, in light of the new evidence, would understand the Microsoft RPC protocol (reported briefly by McKendrick) to be patentably distinct from the claimed document interface.

This is an extraordinary request, unlike any interview request we have ever made. We offer to make a special trip from California for a three-way interview, which is an extraordinary effort on our part, warranted because this is an old case that deserves the attention necessary to put it in condition for allowance. With the technical and legal expertise that the Examiner of record and a specialist can bring to bear, and the familiarity with the technology, law and record that counsel can provide, we should be able to identify and appropriately claim the patentable subject matter in this application.

CONCLUSION

We will follow up in a week to find out if a relatively long interview can be scheduled.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

Respectfully submitted,

Dated: 26 October 2007

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APPENDIX – CBL DISCUSSION OF EVIDENCE FROM RCE pp. 10-14

Slide 31, “CBL status” (reproduced below) explains that CBL already had been used in demonstration applications. This corroborates the inventors’ testimony in declaration paragraph 3 that documents and registries were working for their intended purpose.

CBL Status

- CBL v1.0 contains a few dozen DTDs and modules developed from analysis of ISO, ANSI X.12, other standards
- CBL currently being used by Veo Systems in demonstration applications (Project Seitai, GSA catalog interoperability)
- CBL to be starting “fodder” for CommerceNet-sponsored WG to develop open framework for interoperability of domain-specific commerce languages (just getting under way)

Glushko used this slide to present the new technology and explain how Veo was using CBL definitions of documents in interface specification data structures. With the benefit of Glushko’s slides, one of ordinary skill in the art could read the status report and recognize that these inventors were using CBL as claimed, months before McKendrick’s popular press report.

A 1999 article by inventors Glushko and Meltzer, written with Dr. Jay Tenenbaum of CommerceNet, also gives 1997 as the year for Veo’s technology. Glushko, et al., *An XML Framework for Agent Based E-Commerce*, Communications of the ACM, Vol. 42, No. 3, pp. 106-114 (Mar. 1999). The authors explained their work, at 108: “Conceived originally as a CORBA-based interoperability framework, the eCo System architecture was **recast in 1997 on an XML foundation**, due to XML’s simplicity and widespread adoption ...” This article explains Glushko slides 29 and 30, at pages 112-13.

In a textbook that he co-authored, which qualifies as a prior consistent statement, Professor Glushko again referred to the 1997 work on CBL. “The earliest effort to attack the problem of semantic overlap among XML vocabularies for business applications was the XML **Common Business Library**, whose **first version was released in 1997**.” Glushko and McGrath, *Document Engineering: Analyzing and Designing Documents for Business Informatics and Web Services*, at 130 (MIT Press 2005)

Review of Sall’s Book, the Seybold Transcript, xCBL.org, Allen and Bosak

A reference volume by Kenneth B. Sall, *XML Family of Specifications: A Practical Guide*, at 1073 (Addison Wesley 2002) provides the following glossary-like description of the xCBL e-commerce specification, which again mentions 1997:

Commerce One’s XML Common Business Library promotes “cross-industry exchange of business documents such as product descriptions, purchase orders, invoices, and shipping schedules.” Another goal is “to make the business documents, forms and messages that flow between businesses comprehensible to each business no matter what computer system is used.” **The insightful CBL effort predates the XML 1.0 Recommendation, dating back to 1997.** xCBL uses a mature schema specification (SOX) which is a forerunner of the W3C’s XML Schema Standard. See <http://www.xcbl.org/> for details.

(emphasis added). From this description, we see that “CBL” could be understood by those of skill in the art without any need to attach a copy of the first version of CBL to the declarations.

A transcript of a panel discussion on September 1, 1998 further mentions CBL and provides insights into the level of skill in the art. The Panel was part of the Seybold San Francisco/Publishing ’98 Web Publishing Conference, entitled “Document Standards & Technologies for Commerce Applications”. Glushko was careful about what he said and what he avoided talking about.

Mr. Glushko: ... So we’ve got to find ways to define those common document models for different communities of commerce. And that’s what domain-specific languages are all about, so we’re seeing a lot of activity here. ... This is a great idea but it’s also a terrible idea. You see, XML makes easy-to-create markup languages. That’s the good

thing. The bad thing is that it makes it easy to create mark-up languages. And the value of a mark-up language or any language in general depends on the number of people that speak it ... **If we're not lucky, the whole world will invent its commerce language and we'll have the same problem of the Tower of Babel. We'll have no languages that are mutually intelligible.**

So **our vision** of how this works is as follows: Your company will publish on its Web site essentially a little corner that is the XML corner that will say here's how I want to do business electronically with you. I want to have a service, I'll call it the ordering service, that has two transactions. The first one is a submit transaction, the second one is a transaction, and basically, I'm saying **if you send me a document that conforms to po.dtd, a purchase order, I will send you back a purchase order acknowledgement. And these DTDs could be defined in some global registry or in some commerce registry or some other places all over the world--they should be freely available--that simply say how you want to do business automatically. Well, this is CBL. We have basically just released it to the world this week and after having used it in several demonstration projects, one with the federal government and one with the consortium of Japanese companies, and we have decided to find a way to make this most publicly available and most robust as possible.**

Now we actually have a technology business wrapped around this, which I won't say very much about except that the idea is that if you have common business building blocks, you can define your own document models, expose them to the world, and then have a process which takes those things in and out of your legacy systems.

Audience: Is XML itself stable politically and otherwise?

Mr. Glushko: I sort of think XML is stable enough. There's a proposed recommendation from the W3C that came out in February that people are doing. I think there's always--you could always take a specification and try to aggressively implement or we could say let's use the sort of core stuff, which is not likely to change, and what we're trying to solve is agreement on basic tag sets to simplify the concept, and **our library uses primitive concepts and actually doesn't push the envelope in terms of using XML** as a specification. We're doing things that you could do on your Web site today with very common, easy tools. We're not pushing the envelope with XML. **XML is undergoing a lot of changes.** There's a major

effort coming down the road which is an XML schema language, which would let you describe more data typing and semantic information inside of the XML definition, and that will be really important for commerce.

Another source of information about CBL is the organization xCBL.org, which has continued the development of standard business documents even after Commerce One's demise. On their website, <http://www.xcbl.org/about.shtml>, viewed July 20, 2007, the following historical information appears:

The Evolution of xCBL

xCBL began its life at Veo Systems in 1997. At that time it was called simply CBL, and was a research project partly funded by the Department of Commerce's Advanced Technology Program. CBL was developed to test the limits of XML for e-commerce and to identify requirements for XML design, development, and transaction tools and platforms. Subsequently, Veo invented the first object-oriented XML schema language; SOX, the Schema for Object-Oriented XML; as a result of the lessons learned in the first version of CBL.

This confirms that CBL development was well under way prior to the 1998 date given in the declarations.

The inventor who was not available to sign declarations also published an account of the development of xCBL in 1999, which we accessed at <http://www.infoloom.com/gcaconfs/WEB/granada99/all.HTM>, on July 20, 2007:

I began work on CBL in August 1997. Version 1.1 was released in September 1998, and version 1.2, which is represented in both DTD (Document Type Definition) syntax and SOX, was completed in November 1998. At that point the specification had done its job in providing proof of concept, both to us and to the many who have downloaded the distribution; CBL is currently being employed only as a reference model. Further work is desirable to harmonize CBL semantics with those of EDI (both the X12 and EDIFACT flavors), and with other specifications that have appeared since my CBL work began. In the meantime, we've used a simplified subset of CBL for several successful demo projects.

The 1997 development date is recited yet again.

Jon Bosak, a legendary Sun Microsystems Distinguished Engineer who organized and led the working group that created XML, in April 2005 indicated

his awareness of CBL v1.0 in 1Q1998, consistent with the declarations. See, *UBL Update*, OASIS Symposium on the Future of XML Vocabularies, slide 3 (Apr. 25, 2005) viewed at www.oasis-open.org/events/symposium_2005/slides/bosak.pdf on July 20, 2007. Bosak's date for release of CBL v1.0 is repeated in various OASIS/UBL materials.